



DAC/8
PATENT #5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Pavel Ivanovich LAZAREV, et al.

Serial No.: 09/485,165/8

Group No.:

Filed: February 3, 2000

Examiner:

For: LIQUID CRYSTAL DISPLAY

Attorney Docket No.: U 012593-1

Assistant Commissioner for Patents
Washington, D.C. 20231

RECEIVED

OCT 26 2000

OFFICE OF PETITIONS

Attention: Messrs. Brian Tung & Leonard Smith
PCT Legal Examiners
PCT Legal Office

RESPONSE TO DECISION ON PETITION UNDER 37 CFR 1.47(A)

The Decision on Petition under 37 CFR 1.47(a) of August 16, 2000, required a Declaration (1) from Mr. Cobb stating that no response to the letter of March 6, 2000, was received, (2) indicating that a complete copy of the application papers (including specification, claims, drawings, and oath or declaration) was sent to inventor Beleyaev and (3) indicating the last known address of inventor Beleyaev.

Adjustment date: 03/15/2001 MNGUYEN
10/25/2000 AGOITOM 00000052 09485165
01-FC-215

55.00 OFFICE OF MAILING/TRANSMISSION (37 CFR 1.8a)

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

☒ deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231

03/15/2001 MNGUYEN 00000107 09485168

01-FC-215

Date: October 19, 2000 55.00 OP

10/25/2000 AGOITOM 00000052 09485165

01-FC-215

55.00 OP

FACSIMILE

☐ transmitted by facsimile to the Patent and Trademark Office

Signature

WILLIAM R. EVANS

(type or print name of person certifying)

Such a Declaration of October 6, 2000 is attached.

The Decision on Petition under 37 CFR 1.47(a) set a term of two months for the Declaration. Therefore, a one month's extension petition and fee is required. A check for \$55.00 for the fee is attached.

Respectfully submitted,

JH Cohen by E Ry P 25,858

Julian H. Cohen
c/o Ladas & Parry
26 West 61st Street
New York, New York 10023
Reg. No. 20302
Tel. No. (212) 708-1887



RECEIVED

OCT 26 2000

OFFICE OF PETITIONS

DECLARATION

Re: Patent Application in USA
for "Liquid Crystal Display"

Serial No. 09/485,168
in the name of P. Lazarev et al.

TECHNOLOGY CENTER 1700
OCT 11 2000

RECEIVED

1. I, Carl C. Cobb, President and Chief Executive Officer for Optiva, Inc. at 377 Oyster Point Blvd, Unit 13, South San Francisco, CA 94080, USA, do hereby declare that we filed a U.S. Patent Application Serial No. 09/485,168 (based on PCT/RU98/00250 filed August 3, 1998) for the invention entitled "Liquid Crystal Display" in the name of Pavel Ivanovich LAZAREV; Sergei Vasilievich BELYAEV; and Yuri Alexandrovich BOBROV.
2. We prepared Declaration of the inventors signed by Pavel Ivanovich LAZAREV and Yuri Alexandrovich BOBROV. Signature of Sergei Vasilievich BELYAEV was missing as he was not working for the subcontracting Moscow company ZAO "Quanta Invest" anymore.
3. We prepared and on March 6, 2000 we mailed a letter to Sergei Vasilievich BELYAEV (Exhibit 1) with our request to sign the attached documents for the filing of the above mentioned Patent Application to U.S. Patent Office. We enclosed an Assignment of Invention, Declaration and Power of Attorney to be signed by Sergei Vasilievich BELYAEV, and also a copy of PCT Application (PCT/RU98/00250) as it was filed to U.S. Patent Office.
4. In response to our letter we received an email message from Sergei Vasilievich BELYAEV (Exhibit 2) on March 23, 2000.
5. On March 27, 2000 we prepared and mailed another letter to Sergei Vasilievich BELYAEV (Exhibit 3). Enclosed were an Assignment of Invention, Declaration and Power of Attorney to be signed by Sergei Vasilievich BELYAEV, and a copy of PCT Application (PCT/RU98/00250) as it was filed to U.S. Patent Office – as from the email message we received on March 23, 2000 it was not obvious that an Assignment of Invention, Declaration and Power of Attorney to be signed by Sergei Vasilievich BELYAEV, and a copy of PCT Application (PCT/RU98/00250) was received with our previous package addressed to him.
6. On April 3, 2000 we received an email message from Sergei Vasilievich BELYAEV which is attached as Exhibit 4.
7. On May 9, 2000 we prepared and mailed a letter to Sergei Vasilievich BELYAEV with set of documents enclosed which are relevant to the filing of the U.S. Patent Application Serial No. 09/485,168 (Exhibit 5). It contained the previous correspondence with Sergei Vasilievich BELYAEV with confirmation of receipt; the signed Assignment Deed together with its English translation which states that on August 04, 1997 all the inventors had assigned all their rights for the invention in question to the ZAO "Quanta Invest", the assignee of the priority patent in Russia; and the Assignment Deed signed by ZAO "Quanta Invest" which states the assignment of all rights to the invention in question to OPTIVA, Inc. All above listed documents which were attached to our letter dated May 9, 2000 are attached as Exhibits to the Declaration of Gorodissky & Partners.
8. In response to our letter of May 9, 2000 we received an email message from Sergei Vasilievich BELYAEV (Exhibit 6) on May 28, 2000.

OPTIVA, INC.

377 Oyster Point Boulevard, No. 13
South San Francisco, CA 94080
tel. 650-616-7600
fax. 650-616-7602
www.optivainc.com

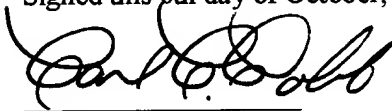
9. On June 19, 2000 we prepared and mailed a letter to Sergei Vasilievich BELYAEV. A copy and delivery confirmation receipts of July 15, 2000 are attached as Exhibit 7.
10. To the best of my knowledge there was no other response, and there was no other correspondence or contact with by Sergei Vasilievich BELYAEV or any of his representatives.
11. To the best of my knowledge here is the last known address of Sergei Vasilievich BELYAEV

Dr. Sergei V. BELYAEV
Russia, 141700, Moscow region,
Dolgoprudny, prospect Patsaeva, d.14, kv.77

It is requested hereby that the above patent application and the accompanying documents be accepted without the original signature of Sergei Vasilievich BELYAEV on the Declaration and Power of Attorney.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application of any patent issued thereon.

Signed this 6th day of October, of the year two thousand



Carl C. Cobb
President and CEO
Optiva, Inc.

Enclosures:

1. Letter from to Mr. BELYAEV of March 6, 2000 (Exhibit 1)
2. E-mail message from Mr. BELYAEV of March 23, 2000 (Exhibit 2)
3. Letter to Mr. BELYAEV of March 27, 2000 (Exhibit 3)
4. E-mail message from by Mr. BELYAEV of April 3, 2000 (Exhibit 4)
5. Letter from to Mr. BELYAEV of May 9, 2000 (Exhibit 5)
6. E-mail message from by Mr. BELYAEV of May 28, 2000 (Exhibit 6)
7. Letter to Mr. BELYAEV of June 19, 2000 and a delivery confirmation receipt (Exhibit 7)



optiva
inc.



Optiva, Inc.
377 Oyster Point Blvd., Unit 13
South San Francisco, CA 94080
Tel 650 616 7600 • Fax 650 616 7602
www.optivainc.com

Exhibit 1.

March 6, 2000

Dr. Sergei V. BELYAEV
Russia, 141700, Moscow region,
Dolgoprudny, prospect Patsaeva, d.14, kv.77

RECEIVED

OCT 26 2000

OFFICE OF PETITIONS

Re: U.S. Patent Application entitled "Liquid Crystal Display"
Priority Pat. Appl.: #97113277, priority date August 4, 1997, Russian Federation
PCT/ RU98/00250; WO 99/06884

Inventors: Belyaev, Sergei V., Bobrov, Yuri A., Lazarev, Pavel I.

Serial No.: to be assigned

Dear Dr. Belyaev:

Enclosed herewith is an Assignment of Invention, Declaration and Power of Attorney to be signed by the inventors for the above-identified patent application. Enclosed please find a copy of PCT Application entitled "Liquid Crystal Display" as it was filed to US Patent Office. Please note that PCT Application was erroneously filed under the name of one inventor only.

Please sign the Assignment of Invention, Declaration and Power of Attorney enclosed in presence of two witnesses and then mail it to Optiva Office at:

Optiva, Inc.
377 Oyster Point Blvd., Suite 13
South San Francisco, CA 94080, USA

or to our Moscow Office at:

Russia, 113455, Moscow
Post Box 24.
Attn: Ms. Inna Lozovskaya

Ms. Inna Lozovskaya could take care of these documents in Moscow and resend them to our Patent Attorney.

If you have any questions regarding this matter, please do not hesitate to contact me.

Sincerely yours,


Carr Cobo
President

Enclosures: - Assignment of Invention, Declaration and Power of Attorney
- a copy of the letter from International Patent Bureau
- a copy of PCT application and translation into English

Optiva - Alla Sakharova

From: Carl Cobb [carlcobb@cobbweb.com]
Sent: Thursday, March 23, 2000 10:25 AM
To: Alla Sakharova
Cc: plazarev@optivainc.com; carlcobb@optivainc.com
Subject: Belyaev re: PCT application

>X-Originating-IP: [211.51.196.142]
>From: "Sergey Belyaev" <belsv@hotmail.com>
>To: carlcobb@cobbweb.com
>Subject: PCT application
>Date: Thu, 23 Mar 2000 04:54:55 PST
>X-Rcpt-To: carlcobb@cobbweb.com
>
>March 23, 2000
>
>Mr. Carl Gobb,
>President,
>Optiva Inc.
>
>
>Dear Mr. Gobb:
>
>After your Fax of March 8 ,2000 concerning U.S. Patent Applications entitled
>"Dichroic Polarizer" we would like to inform and ask you the following.
>
>We need to consider this PCT application with one author only as not an
>error, but as real authors rights violation. For this reason please confirm
>this "error" was corrected with respect to all indicated countries, not for
>USA only (maybe we have received not all corrected documents, but this
>"error" remains in Internet publication).
>
>
>Regards,
>
>On behalf of inventors Sergey Belyaev, Nicolay Malimonenko, Alexander
>Miroshin:
>
>Sergey Belyaev ,
>e-mail: belsv@hotmail.com
>
>
>Get Your Private, Free Email at <http://www.hotmail.com>
>
>
>
Carl C. Cobb
Optiva, Inc.
650-616-7600 f: 650-616-7602

Optiva - Alla Sakharova

From: Carl Cobb [carlcobb@optivainc.com]
Sent: Tuesday, March 28, 2000 11:39 AM
To: Sergey Belyaev
Subject: PCT applications

27 March, 2000

To: Dr. Sergey Belyaev

Re: Patent Application entitled "Dichroic Polarizer"
Priority Pat. Appl.: #97113613, priority date August 11, 1997,
Russian Federation
PCT/ RU98/00251; WO 99/08140

Re: Patent Application entitled "Liquid Crystal Display"
Priority Pat. Appl.: #97113277, priority date August 4, 1997,
Russian Federation
PCT/ RU98/00250; WO 99/06884

Dear Dr. Belyaev

We received your correspondence dated March 23, 2000.

We would like to inform you that we have applied all efforts to correct the misprint that omitted your names in the above mentioned PCT applications as inventors. The mistake was made by the Russian Patent office clerk. This mistake lead to an erroneous publication of the list of inventors in PCT publication.

>From legal stand point it is an obvious misprint which is treated as such by Patent Offices in all countries of filing.

Materials that intended to clear this point are in the mail and we would appreciate your notification of reception in order to file it with our representing patent office in Russia. For the application of the above-mentioned patent applications to the national stage Optiva is represented by Gorodissky Patent Law Firm.

At the beginning of March we forwarded a set of documents to your attention by mail that probably did not reach you. We mail to you the same set of documents once more. It contains:

- Assignment of Invention, Declaration and Power of Attorney
- a copy of the letter from International Patent Bureau (that confirms the corrected PCT application)
- a copy of PCT application and translation into English

Please forward the copy of this letter to Mr. Nikolay Malimonenko and Mr. Alexandre Miroshin.

The notation of "USA only" refers ONLY to the difference in US Patent law, in which the applicant is considered to be the author(s) or the assignee of the author(s). This is for the purpose of US patent registration.

As your request, and as Optiva is already taking action to do, the correction of authorship error of the Russian patent office is for all countries.

Please, do not hesitate to call us if you would have any questions.

Best regards.

Carl Cobb

cc. Gorodissky Law Offices

Carl C. Cobb
Optiva, Inc.
650-616-7600

X-Originating-IP: [195.239.4.144]
From: "Sergey Belyaev" <belsv@hotmail.com>
To: carlcobb@optivainc.com
Cc: mirs@postman.ru
Date: Mon, 03 Apr 2000 03:57:14 PDT
X-Loop-Detect: 1

April 3, 2000

Mr. Carl Cobb,
President, Optiva Inc.
carlcobb@optivainc.com

Re: Patent Application entitled "Dichroic Polarizer" Priority Pat.
Appl.: #97113613, priority date August 11, 1997, Russian Federation PCT/
RU98/00251; WO 99/08140

Re: Patent Application entitled "Liquid Crystal Display" Priority
Pat. Appl.: #97113277, priority date August 4, 1997, Russian Federation PCT/
RU98/00250; WO 99/06884

Dear Mr. Cobb:

Thank you for your e-mail of 30 March, 2000. I apologize for an error at your name writing in my e-mail of 23 March, 2000 – Fax received by me was very unclear.

We appreciate Optiva attempts to correct the mistakes with our authorship for discussed PCT applications with respect to all indicated countries.

We can not consider the conditions proposed by Optiva for Assignment of Invention ("One US dollar") as obvious for us, because Optiva did not fulfilled the conditions promised for us by Mr.P.Lazarev when we joint with Optiva (it was the reason we have preferred to leave Optiva). No agreements were signed between us and Optiva during our work at Optiva, especially agreements for patents generated by us. For these reasons we would like to discuss with you the realistic conditions for our rights transfer to Optiva.

Two options could be considered.

1) We could sign improved Assignments of Inventions and other needed documents if Optiva agrees with the share as 10% of ownership for each of three inventors (Belyaev, Malimonenko, Miroshin) for "Dichroic Polarizer" (total 30% of ownership) and the share 15% of ownership for Belyaev for "Liquid Crystal Display".

2) We could sign the Assignments of Inventions and other needed documents if Optiva pays US \$ 10,000 for each of three inventors (Belyaev, Malimonenko, Miroshin) for "Dichroic Polarizer" and US \$ 10,000 for Belyaev for "Liquid Crystal Display".

Please, do not hesitate to inform us if you have better proposals.

Best regards.

On behalf of inventors Sergey Belyaev, Nicolay Malimonenko, Alexader Miroshin:
Sergey Belyaev , e-mail: belsv@hotmail.com

cc. Mr.A.Miroshin, mirs@postman.ru

Get Your Private, Free Email at <http://www.hotmail.com>

Exhibit 5

Gorodissky & Partners
Bolshaya Spasskaya Str. 25, str. 3
Moscow 129010, Russia
Ph. +7095 937 6116
Fax +7095 937 6104/23

May 9, 2000

Re: US Patent Application entitled "Liquid Crystal Polarizer"

Your Reference: Gorodissky&Partners: 2412-P469-3.PM

In answer to your inquiry on the signed Declaration for the above-mentioned Patent application to the U.S. Patent Office, we are informing you that Declaration by now is signed by two Inventors – Yuri Bobrov and Pavel Lazarev.

We forward to you a copy of our Letter to each Inventor of this Application dated March 6, 2000. We have confirmation of receiving from the inventor Sergey Belyaev, dated March 31, 2000.

Optiva does not have a signed Declaration from Sergey Belyaev. Although we do not have the signed Declaration, we would like to ask you to communicate with the US Patent Attorney and inform him about this matter.

At the same time we have an Assignment, signed by inventors, which transfers all rights to the Company "Quanta Invest", the assignee of the priority patent application in Russia. We also enclose the Assignment Deed that assigns rights for the U.S. Patent application entitled "Liquid Crystal Polarizer" from "Quanta Invest" to "Optiva, Inc."

Enclosed please find the following documents:

- Optiva's letter addressed to Sergey Belyaev dated March 6, 2000 with confirmation of receipt;
- signed Assignment (a copy) by all inventors dated at August 04, 1997 that declares that all rights including world-wide patent applications are assigned to "Quanta Invest" (in Russian),
- English translation of the Assignment, and
- Assignment Deed signed by the assignor (Quanta Invest) and the assignee (Optiva, Inc.)

If we receive signed documents from Sergey Belyaev, we will forward it to you for filing with US Patent Office.

Thank you for your service.

Very truly yours,

Alla Sakharova, PhD
Project Manager
allas@optivainc.com

Exhibit 6.

>X-Originating-IP: [210.223.221.73]
>From: "Sergey Belyaev" <belsv@hotmail.com>
>To: carlcobb@optivainc.com
>Subject: Re: PCT applications
>Date: Sun, 28 May 2000 07:09:18 PDT
>X-Loop-Detect: 1
>
>May 28, 2000
>Mr. Carl Cobb,
>carlcobb@optivainc.com
>President, Optiva Inc.
>Re: Patent Application entitled "Dichroic Polarizer" Priority Pat.
>Appl.: #97113613, priority date August 11, 1997, Russian Federation PCT/
>RU98/00251; WO 99/08140
>Re: Patent Application entitled "Liquid Crystal Display" Priority
>Pat. Appl.: #97113277, priority date August 4, 1997, Russian Federation PCT/
>RU98/00250; WO 99/06884
>
>Dear Mr. Cobb:
>Unfortunately, we have not received during two months Optiva's answer
>concerning our proposals for the possible rights transfer conditions for
>mentioned Patent Applications. Moreover, there is no corrections so far in
>Internet for proper PCT publications you informed us.
>
>As you understand in accordance with USPTO rules without our signatures at
>Assignment of Invention the authors continue be as owners of the inventions.
>Now Optiva and the authors have approx. one month to find a joint problem
>solution. After this period Optiva will deal with our agents and investor.
>Please inform us about your opinion concerning discussed subjects.
>
>Best regards
>Sergey Belyaev
>
>
>

19 June, 2000

Dr. Sergei V. BELYAEV Russia, 141700, Moscow region,
Dolgoprudny, prospect Patsaeva, d.14, kv.77

Re: U.S. Patent Application entitled "Liquid Crystal Display"
Priority Pat. AppL: #97113277, priority date August 4,
1997, Russian Federation PCT/ RU98/00250; WO 99/06884
Inventors: Belyaev, Sergei V., Bobrov, Yuri A., Lazarev, Pavel I.

Dear Dr. Belyaev,

We received your correspondence dated May 28, 2000.

As I noted in my previous message, Optiva has applied all efforts to correct the misprint that omitted your names as inventors in the above mentioned PCT applications. The PCT publication is published based on this erroneous information, and it is now being fixed in the published text now. The Internet copy you are referring to is based on the published notice.

The main purpose for the PCT application is not publication itself. This structure was created to protect your rights for your intellectual property under national Patent laws. As we had already informed you before, all actions to correct these errors in national patent applications have been taken care of, and we are receiving responses from the national Patent Offices with confirmations of the fixed errors. So, for each country, the complete set of inventors has been filed.

I believe that you have an obvious misreading of the notation from the PCT Office response that the applicants are considered to be the authors in USA only. And hopefully, you realize now the legal situation with Inventors' names for patent applications based on the Russian priority patent application.

Regarding the filing of the above-mentioned application to the U.S. Patent Office, you are exactly right, and Optiva should send you all signed documents in the nearest future. That was the reason why several months ago you received Declaration and Assignment that was mailed to you by Optiva with a set of other documents relevant to this matter. Unfortunately, we have not yet received the signed forms from you.

OPTIVA, INC.

377 Oyster Point Boulevard, No. 13 South
San Francisco, CA 94080 tel. 650-616-7600

Optiva will file Declaration and Assignment with all signatures obtained at the time of the filing. We would appreciate if you would consider providing your signature on those forms being delivered to us in time so that we may include them.

Concerning your proposal, contained in your email message as of April 3rd, 2000, on the financial compensations of the rights' transfer, I would like to be clear in order to avoid any possible misunderstanding in the future.

Optiva will not consider additional payments for patents to which Optiva already has rights.

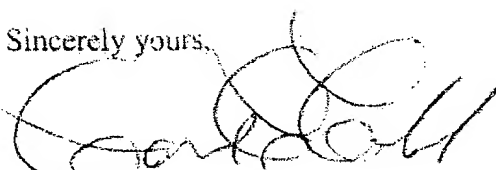
Those patent applications were created for Optiva. Optiva provided payment to its subcontractor, Quanta Invest, for the work performed and for the patents resulting from that work.

Quanta Invest provided payments to employees and consultants for the work performed, and received the work and the patent rights to the work in turn.

This in no way minimizes the work, or the scientific talent of those, including yourself, who performed the study, which resulted in the patents. On the contrary, I appreciate and admire the level of scientific achievement. Our position is a business matter, and it is merely that after payment in full, no further compensation is due.

We highly appreciate your understanding and hope that you would positively consider signing Declaration and Assignment for the above-mentioned US Patent application.

Sincerely yours,



Carl Cobb
President

3/н из Москва За № 234 (почт. квит.)
 ценностью на руб. с наложенным
 платежом на руб., отправленное 07/07. 2000 (число, месяц, год)
 по адресу 141700 Моск. обл., г. Лобня
 Крутицкий, пр. Гагарина, д. 14, к. 15
 на имя Бенева С.В.

Вручен « 10 » мая 19 г. по доверенности (кому) Бенева
 Подпись руководителя организации почтовой связи (цеха, участка)
 (календ. шт. дня для отправления почт. уведомления)

Обведенное жирной чертой заполняется отправителем

3/н из Москва За № 235 (почт. квит.)
 ценностью на руб. с наложенным
 платежом на руб., отправленное 07.07. 00 (число, месяц, год)
 по адресу 125021 Москва, ул. Петрова
 Заверская, д. 17 к. 2, кв. 15-2
 на имя Митрошина А.А.

Вручен « 15 » июня 2000 г. лично по доверенности (кому) Митрошин
 Подпись руководителя организации почтовой связи (цеха, участка)
 (календ. шт. дня для отправления почт. уведомления)

Обведенное жирной чертой заполняется отправителем

3/н из Москва За № 233 (почт. квит.)
 ценностью на руб. с наложенным
 платежом на руб., отправленное 07.07. 00 (число, месяц, год)
 по адресу 141730 Моск. обл., г. Лобня,
 ул. Ленина, д. 6-3, кв. 18
 на имя Мамонтова Н.В.

Вручен « 12 » 07 00 г. по доверенности (кому) Мамонтов
 Подпись руководителя организации почтовой связи (цеха, участка)
 (календ. шт. дня для отправления почт. уведомления)

Обведенное жирной чертой заполняется отправителем

RECEIVED

OCT 26 2000

OFFICE OF PETITIONS

3 **ПОЧТА РОССИИ** № 0784

РОССИЯ 0.25 1.50

Федеральное управление почтовой связи Р

Уведомление о вручении почтового отправления, заказное, авиа, телеграфное, срочное телегра (нужное подчеркнуть)

Куда Москва, 113455,
а/е 24

Кому Сахаровой А.А.

ПОЧТА РОССИИ 260700166 МОСКВА М-455

(кален. шт. дня поступления уведомления)

Индекс предприятия связи места назначения

Ф. 119

РОССИЯ 0.25 1.50

Федеральное управление почтовой связи Р

Уведомление о вручении почтового отправления, заказное, авиа, телеграфное, срочное телегра (нужное подчеркнуть)

Куда Москва, 113455,
а/е 24

Кому Сахаровой А.А.

ПОЧТА РОССИИ 260700166 МОСКВА М-455

(кален. шт. дня поступления уведомления)

Индекс предприятия связи места назначения

RECEIVED
OCT 26 2000

Ф. 283

Федеральное управление почтовой связи Р

Уведомление о вручении почтового отправления, заказное, авиа, телеграфное, срочное телегра (нужное подчеркнуть)

Куда Москва, 113455
а/е 24

Кому Сахаровой А.А.

ПОЧТА РОССИИ 260700166 МОСКВА М-455

(кален. шт. дня поступления уведомления)

Индекс предприятия связи места назначения

